



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/551,189

04/17/2000

Alexander Mashinsky

9118-046

1300

20583

7590

03/03/2003

PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Francis Morris 212-790-9090

Office Action Summary

Application No.

09/551,189

Applicant(s)

MASHINSKY, ALEXANDER

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-70 is/are rejected.
- 7) ☒ Claim(s) 67 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Objections

1. Claim 67 is objected to because of the following informalities: The phrase “a least” (line 1 of claim 67) should read “at least”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2645

2. Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “determining the most recent time that the first.....determining the most recent time that the second.....if the first communication device.....if the second communication device.....via the second network” of claim 38 is not disclosed by the specification. On Lines 13-14 and line 22 page 7, the specification disclosed determining communication networks that is being used by the called party. Nowhere in the specification disclosed determining most recent connected network.

3. Claim 53 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “selecting comprises the execution of a call setup procedure” of claim 53 is not disclosed by the specification. By the context of specifications, the “selecting” is executed before the call is determined how to setup.

4. Claim 67 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “data base includes at least cost routing table” of claim 67 is not disclosed by the specification. On line 28 page 13 of the specifications disclosed consideration such as cost. The

Art Unit: 2645

specifications did not disclose the data base includes at least "cost routing table". Also, the specification did not disclose "cost routing table comprising prioritized entries of costs of routing".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 38-49, 51, 53-62, 65, 66, 69 and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepe et al (US: 5742905).

Regarding claims 38-43, Pepe et al teach on Fig. 1 a telephone (claimed "first communication device") and a PDA (typically a notebook computer, column 1 line 32-35; the

Art Unit: 2645

claimed "second communication device"). Each communication devices is connected via separate network (claimed "first" and "second" networks). The telephone and PDA are associated with an individual and receive a communication for the individual. Pepe et al also teach on column 23 line 63 to column 24 line 3, when subscriber's wireless terminal is not activated the subscriber directs the PCI to send notification of phone calls to the pager and to route the call to voice mail. The "route the call to voice mail" reads on the claimed "otherwise, if the second communication device is connected.....transmitting the communication.....to the second communication device". Regarding first and second geographical area of claims 40 and 43, the telephone (item 26 Fig. 1 of Pepe et al) is stationed in an office while the PDA (item 30 Fig. 1 of Pepe et al) is for a mobile subscriber at a different geographical area (outside of the office) to use.

For claims 44, 49, Pepe et al teach a method for routing telecommunications traffic. Regarding section (a), Pepe et al teach on column 23 line 63 to column 24 line 3, when subscriber's wireless terminal is not activated the subscriber directs the PCI to send notification of phone calls to the pager and to route the call to voice mail. The network connecting subscriber's wireless terminal is the claimed "first telecommunications network". The "subscriber directs" of Pepe et al reads on the claimed "one or more criteria". Regarding section (b)(c)(d)(e)(f), Pepe et al teach on column 27 line 14-21, the voice mail system may use AMIS – analog protocol to connect analog voice messages to the PCI while the AMIS is not required should the subscriber's wireless terminal is activated and the call is connected to the subscriber.

Art Unit: 2645

For claims 45-48 and 70, Pepe et al teach on column 5 line 35-36 "PSTN" (the claimed "circuit switched network"). Pepe et al also teach on Fig. 1 "wireless network" (the claimed "cellular network").

Regarding claims 51 and 66, Pepe et al teach on column 2 line 60-63 credit database.

Regarding claim 53, Pepe et al teach on column 23 line 63 to column 24 line 3, when subscriber's wireless terminal is not activated the subscriber directs the PCI to send notification of phone calls to the pager and to route the call to voice mail. Pepe et al teach on column 23 line 63 to column 24 line 3, when subscriber's wireless terminal is not activated the subscriber directs the PCI to send notification of phone calls to the pager and to route the call to voice mail. When the "voice mail" routing is selected the call is setup to the voice mail machine.

Regarding claim 54, Pepe et al teach on column 4 line 43-44, the PCI database maintains the subscriber profile (the claimed "subscriber information").

Regarding claims 55 and 69, Pepe et al teach on column 5 line 39 "Internet". It is inherent that traffic on Internet must be formatted according to the Internet Protocol for transmission.

Regarding claim 56, Pepe et al teach on Fig. 1 voice (telephone) and fax.

Art Unit: 2645

Regarding claim 57, Pepe et al teach on column 5 line 56-59, the subscriber can send and receive messages between disparate networks. The “send and receive” reads on a two-way communication which the claimed “receiving.....the called party’s telecommunications traffic and transmitting.....to the calling party”.

Regarding claims 58 and 59, when the subscriber send messages it is inherent that signaling message must be included for setting a call and the signaling message must include supervision signal (to identify the availability of trunk, line, etc.).

Regarding claims 60-62, Pepe et al teach on column 7 line 45-48 “ATM”, “TCP/IP” and “Frame Relay”.

Regarding claim 65, Pepe et al teach on item 52 Fig. 4 “CO”. The “CO” is the claimed first central local node connecting the wireline network (the claimed “first telecommunication network”) and the wireless network (the claimed “data network” for connecting the PDA). Inherently, the second telecommunications network (“wireless network” of Pepe et al) must have a mobile switch office (the claimed “second central local node”).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 50 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al as applied to claim 49 above, and in view of Takase et al (US-PAT-NO: 5,042,027). Pepe et al failed to teach the user preferences include a specified level of transmission quality. However, Takase et al teach on column 5 line 67 to column 6 line 2, the allowable traffic in the routing table is determined in accordance with the communication performance quality. It would have been obvious to one skilled at the time the invention was made to modify Pepe et al to have the user preferences include a specified level of transmission quality as taught by Takase et al such that the modified system of Pepe et al would be able to support the transmission quality as a preference for routing to the system users.

7. Claims 52 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al as applied to claim 44 above, and in view of Moll (US: 5027387). Pepe et al failed to teach the one or more criteria include costs of routing through the one or more data networks. However, Moll teaches on column 1 line 56-59, the call is routed based on the calling cost. It would have been obvious to one skilled at the time the invention was made to modify Pepe et al to have the one or more criteria include costs of routing through the one or more data networks as taught by

Art Unit: 2645

Moll such that the modified system of Pepe et al would be able to support the cost as preference for routing to the system users.

8. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al (US: 5452350), and in view of Li et al (US: 5617423). Reynolds et al teach on column 10 line 20-40 “selection function” (the claimed “evaluating”) to determine performance criteria (the claimed “transmission quality”) and selecting the routing path. Reynolds et al failed to teach voice-over-data-network. However, Li et al teach on Abstract ‘connection between first site and local site may operate in a voice over data communication mode”. It would have been obvious to one skilled at the time the invention was made to modify Reynolds et al to have the voice-over-data-network as taught by Li et al such that the modified system of Reynolds et al would be able to support the voice-over-data-network to the system users.

Conclusion

9. The prior art made of record and not replied upon is considered pertinent to applicant’s disclosure.

- Marsh et al (US: 5463671) teach telecommunications network having a distributed network of decentralized local stations.

Art Unit: 2645

10. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

